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PRE-APPEAL BRIEF REQUEST FOR REVIEWDocket Number (Optional)
Q60128

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Typed or printed name _____

Application Number

09/694,057

Filed

August 7, 2000

First Named Inventor

Patrick HUMBERT, et al.

Art Unit

1731

Examiner

John M. Hoffmann

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record. 32,778
Registration number _____ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Brian W. Hannon

Typed or printed name

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Telephone number

January 9, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

*Total of 10 forms are submitted.

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PATENT APPLICATION.**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of

Docket No: Q60128

Patrick HUMBERT, et al.

Appln. No.: 09/694,057

Group Art Unit: 1731

Confirmation No.: 9140

Examiner: John M. Hoffmann

Filed: August 7, 2000

For: APPARATUS FOR SUPPORTING A PREFORM AN INSTALLATION FOR
MANUFACTURING OR BUILDING UP A PREFORM AND PROVIDED WITH
SUCH APPARATUS, METHODS IMPLEMENTED IN SUCH AN
INSTALLATION, AND A PREFORM MADE USING SUCH METHODS

REQUEST FOR PRE APPEAL BRIEF CONFERENCE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Pursuant to the new pre-Appeal Brief Conference Pilot Program, and further to the Examiner's final Office Action, dated July 7, 2005, Applicants file this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicants turn now to the rejections and objections at issue.

I. OBJECTION TO REVISED DRAWING AS CONTAINING NEW MATTER:

In the Response filed June 7, 2005, Applicants submitted corrected Figure 1 labeling the box in the bottom left corner with reference number 12. This was in response to an objection entered by the Examiner in the first Office Action of February 24, 2005, in which the Examiner correctly noted that servo-control means 12 (discussed, e.g., at page 6, line 36 of the application) was not identified in the drawings.

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The Examiner contends that the proposed drawing contains the matter because there is no support in the specification for the box being labeled "12". In support, the Examiner cites to page 6, lines 29-36 and contends that this portion of the specification requires that the structure 12 be part of the control support means 7. Applicants agree with the Examiner that the specification states that the servo control means is part of the control means 7. Specifically, the specification states that the control support means 7 includes the means 9 (top left in Fig. 1) for measuring the sag of the preform; at least one support element 10 mounted on the control positioning means 11; and the servo-control means 12. However, Applicants are at a loss as to why this could possibly preclude the box of the lower left corner in Figure 1 from corresponding to the claimed servo-control means. In this respect, Applicants note that the specification states that the servo-control means 12 is "for servo-controlling the controlled positioning means 11 in the active end position to a controllable predetermined reference value C for the sag of the preform 1." Page 6, line 36 to page 7, line 2 of the specification. The dotted arrow in the bottom left hand corner of Figure 1 labeled "C" obviously corresponds to reference values C which is inputted into the servo-control means 12, as explained above. Thus, it is clear from the specification that this box 12 is intended to correspond to the claimed servo-control means. Thus, it is respectfully submitted that the new matter rejection is improper and should be withdrawn.

The Examiner has further objected to the drawings noting that reference numeral 12 has been used to designate both a servo-control means and a computer. However, it is clear from the specification that the servo-control means 12 corresponds to a computer -- they are the same elements. To clarify this, Applicants attempted to amend page 6 of the specification to clarify

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that the servo-control means includes a computer. However, the Examiner refused to enter this Amendment. It is respectfully requested that this amendment be entered to clarify the specification and to fully resolve the objection to the drawings.

II. OBJECTION TO THE CLAIMS 12-14 UNDER § 112 (first paragraph):

The Examiner has rejected claims 12-14 under § 112 (first paragraph) for failing to describe the servo-controller being coupled to the sensor, as claim 12 requires. This rejection is related to the new matter rejection and, specifically, the Examiner's unwillingness to agree that the box in the lower left hand corner of Figure 1 corresponds to the claimed servo-controller. Specifically, on page 4 of the Office Action, the Examiner acknowledges that this box is coupled to the sensor 9. Thus, resolving the new matter rejection should likewise resolve this § 112 (first paragraph) rejection.

III. SECTION 103 REJECTION OF INDEPENDENT CLAIM 11:

It is first noted that the Examiner has not rejected claims 12-14 on prior art grounds. Thus, it is assumed that these claims are deemed allowable.

On the other hand, the Examiner has rejected independent claim 11 under §103 as being unpatentable over a combination of five references including: Blankenship (U.S. patent No. 4,310,339), Sharp (U.S. Patent No. 4,867,776), Mimura (U.S. Patent No. 4,729,777), Bickel (DE 4009484) and Hara (U.S. Patent No. 4,552,576).

As a preliminary matter, Applicants submit that the Examiner's rejection is fatal on its face because the Examiner has not clearly articulated exactly how or why a person of ordinary skill in the art would have modified the device disclosed in Blankenship in view of the four

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secondary references. Thus, Applicants are simply unable to understand the basis of the rejection.

Independent claim 11 is directed to an apparatus which supports a preform for its manufacture. According to the invention, the apparatus includes a rotation mechanism that rotates the supporting core of the pre-form about a horizontal axis. In addition, the apparatus includes an adjustable support member and a rotatable wheel mounted on the adjustable support member. The rotatable wheel has a rotational axis which is parallel to the supporting core, is mounted to rotate freely, and includes a tread strip which comes into tangential contact with the preform.

The primary reference, Blankenship, relates to a conventional apparatus for forming a preform in which the preform extends in the vertical direction and not the horizontal direction, as required by independent claim 11.

As best Applicants can understand, the Examiner contends that it would have been obvious to orient Blankenship apparatus horizontally so that one does not need a high drawing turret. Further, the motivation for changing the orientation of the Blankenship apparatus is based upon the teachings in Bickel which the Examiner contends discloses "that producing fibers horizontally has the advantages of not needing a high drawing turret." Final Office Action at page 6.

The problem with the Examiner's obviousness determination is that whereas Blankenship is directed to an apparatus for forming a preform which is later used to form an optical fiber, Bickel is directed to an apparatus for forming the optical fiber from a previously made preform. Bickel teaches nothing with respect to the apparatus for forming a preform. In other words,

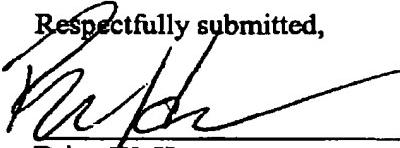
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comparing Blankenship and Bickel is like comparing apples and oranges; they are completely different from one another. Thus, the mere fact that Bickel discloses a concept of drawing an optical fiber using a horizontal arrangement so that a high drawing tower is not necessary, would clearly not motivate a person of ordinary skill in the art to orient the Blankenship apparatus for forming a preform horizontally. This can be easily appreciated by considering the Examiner's statement that "it would have been obvious to orient the Blankenship apparatus, so that one does not need a high drawing turret." Final Office Action at page 6. High drawing turrets are used for forming optical fibers from a preform; they are not used to form the preform itself. Indeed, even a cursory review of Blankenship shows that there is no disclosure of using the high drawing turret for forming the preform. Anyone with a basic understanding of this technology would understand the distinction between an apparatus of forming a preform and an apparatus for forming an optical fiber from a previously made preform.

Since the Examiner's obviousness determination is improper, it is clear that the rejection cannot stand. Thus, it is requested that all claims pending in the application be allowed to issue.

Please also credit any overpayments to said Deposit Account. A duplicate copy of this sheet is enclosed.

Respectfully submitted,



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Date: January 9, 2006